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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,921	12/03/2003	Joachim Fiedler	GK-GEY-1093CIP / 500350.2	4721
26418	7590	09/18/2006	EXAMINER ANDERSON, CATHARINE L	
REED SMITH, LLP ATTN: PATENT RECORDS DEPARTMENT 599 LEXINGTON AVENUE, 29TH FLOOR NEW YORK, NY 10022-7650			ART UNIT 3761	
PAPER NUMBER				

DATE MAILED: 09/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/726,921

Applicant(s)

FIEDLER ET AL.

Examiner

C. Lynne Anderson

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 19-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/762,298.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Newly submitted claims 19-21 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 19-21 disclose a process for removing waste products that does not require the apparatus of claims 1-28.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 19-21 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Terminal Disclaimer***

It is directed to a particular claim or claims, which is not acceptable, since "the disclaimer must be of a terminal portion of the term of the entire [patent or] patent to be granted." See MPEP § 1490.

### ***Response to Arguments***

Applicant's arguments filed 10 July 2006 have been fully considered but they are not persuasive.

In response to applicant's argument that the claimed invention is used in the dermatological field, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In response to applicant's argument that Wilk fails to disclose a tubular channel having an orifice through which laser radiation is directed, it is noted that Wilk discloses a tubular channel 106, which extends into channels 102 and 104, as shown in figure 13, to provide an opening (i.e. an orifice) through which laser radiation is directed.

In response to applicant's argument that the laser is not part of the invention of Wilk, it is noted that Wilk discloses the use of a laser 121, as shown in figure 13.

In response to applicant's argument that Cosmescu fails to disclose a tubular channel having an inner wall which has an outlet, it is noted that the rejection in view of Cosmescu does not rely on the "exhaust holes" 92 as the outlet. Rather, Cosmescu discloses a tubular channel 80, and gas is directed to the center of the tubular channel 80 through hole 86, as shown in figure 2.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8-9, 12, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilk (5,279,599).

With respect to claims 1 and 18, Wilk discloses an arrangement for the suction removal of waste products, as shown in figure 13, comprising a tubular channel 106 comprises an orifice surrounding the surgical site 118 through which a laser 121 is directed. The tubular channel 106 has an inner wall comprising at least one outlet

opening 110 in the vicinity of the orifice. The arrangement of Wilk is fully capable of being used to remove waste products during ophthalmic surgery.

With respect to claim 2, the gas flow is directed in substantially the opposite direction of the laser 121.

With respect to claim 3, the tubular channel 106 has a portion which tapers conically, shown in figure 13 but not numbered.

With respect to claim 4, the tubular channel 106 has two chambers 102 and 104 extending concentrically around its circumference, as shown in figure 13.

With respect to claim 5, a plurality of outlet openings 110 are arranged in a radial symmetric manner, as shown in figure 13.

With respect to claim 6, the at least one outlet opening 110 extends annularly, as shown in figure 13.

With respect to claim 8, the at least one outlet opening 110 is connected with a pressure vessel filled with air, as described in column 4, lines 59-60.

With respect to claim 9, the inner wall of the tubular channel 106 has a plurality of suction openings 112 arranged in a radial symmetric manner which communicate with a suction device, as shown in figure 13.

With respect to claim 12, the tubular channel 106 is capable of being swiveled relative to the laser 121, and the laser beam is enclosed by the tubular channel 106, as shown in figure 13.

Claims 13-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Cosmescu (5,199,944).

Cosmescu discloses an arrangement for the suction removal of waste products comprising a tubular channel 80 having an orifice through which laser radiation 81 is directed, as shown in figure 2. The tubular channel 80 has an inner wall having outlet openings 86 for a gas, and the flow of gas is directed to the center of the tubular channel 80, as shown in figure 2. The arrangement has a treatment phase in which laser radiation is directed to the tissue before the gas flow is activated, as disclosed in column 5, lines 18-24, and a cleaning phase in which the laser radiation is interrupted and the gas flow is directed to the center of the tubular column, as disclosed in column 4, lines 25-29.

With respect to claims 14-16, a shutter 88 switches on and off the gas flow, as disclosed in column 4, lines 33-34. The shutter 88 is a stopcock, which is rotatable and comprises rotary perforations.

With respect to claim 17, the laser radiation is fully capable of being turned on for a predetermined number of pulses, and device 26 controls the shutter to switch on the gas flow for a predetermined time period while the laser radiation is turned off, as disclosed in column 4, lines 25-29.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk (5,279,599).

Wilk discloses all aspects of the claimed invention but does not specifically claim a device for interrupting the laser radiation. It is well-known in the art to provide a means for starting and stopping the laser radiation, such as an on/off switch, and it would have been obvious to one of ordinary skill in the art at the time of invention to construct the arrangement of Wilk with a device for stopping the laser radiation.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 7 and 10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 9 of U.S. Patent No.

6,752,778. Although the conflicting claims are not identical, they are not patentably

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distinct from each other because the claims differ only in the intended use of the instant invention on ocular tissue.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Lynne Anderson whose telephone number is (571) 272-4932. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CNA

cla

September 14, 2006

TATYANA ZALUKAEVA  
SUPERVISORY PATENT EXAMINER

